REMARKS

In the July 6, 2005 Office Action, all of claims 1-4, 7-14, and 17-20 stand rejected in view of prior art. No other objections or rejections are made in the Office Action.

Status of Claims and Amendments

In response to the July 6, 2005 Office Action, Applicants respectfully traverse the rejections. Currently, claims 1-4, 7-14, and 17-20 are pending, with claims 1 and 12 being the only independent claims. Reexamination and reconsideration of the pending claims are respectfully requested in view of the following comments.

Rejections - 35 U.S.C. § 103

On pages 2-4 of the Office Action, claims 1-4, 7-14, and 17-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the U.S. Patent No. 3,296,731 to Wood ("Wood patent") in view of U.S. Patent Application Publication No. 2003/0146325 to Kitajima ("Kitajima patent") and U.S. Patent No. 6,409,113 to Hirayama ("Hirayama patent"). Claims 9-11 and 18-20 stand rejected as being unpatentable over the Wood patent in view of the Kitajima patent, the Hirayama patent, and U.S. Patent Application Publication No. 2003/0146324 to Yeh ("Yeh patent"). In response, Applicants respectfully traverse the rejections.

Applicants believe that the Kitajima patent should be disqualified from prior art under 35 U.S.C. § 103(c) for the purpose of these rejections. The language of §103(c) states that

> Subject matter ***developed by another person***, which qualifies as ***prior art only*** under one or more of subsections ***(e), (f), and (g) of section 102*** of this title, ***shall not preclude patentability*** under this section where the subject matter and the claimed invention were, at the time the invention was made, ***owned by the same person or subject to an obligation of assignment to the same person***.

(emphasis added). In other words, for the disqualification under §103(c) to apply, the reference must (1) qualify as prior art only under one or more of 35 U.S.C. §102(e), (f), or (g), (2) be developed by another person, and (3) be owned by or subject to an obligation of assignment to the same person. Applicants believe that the Kitajima patent satisfies all of these three criteria.

First of all, Applicants believe that the Kitajima patent is a prior art under §102(e), but ***not*** under §102(a). Applicants specifically disagree with the Office Action's assertion that the Kitajima patent qualifies as prior art under §102(a).

The language of 35 U.S.C. §102(a) states that:

> A person shall be entitled to a patent unless -
>
> (a) the invention was ***known or used*** by others in this country, or patented or described in a ***printed publication*** in this or a foreign country, ***before the invention thereof by the applicant*** for patent,

(emphasis added).

Applicants respectfully object to the Office Action's assertion that the invention of the Kitajima patent was known or used by others in this country as of the filing date of the Kitajima patent. Applicants do not understand on what basis the Office Action makes such assertion. Applicants have made no admission or submitted any evidence of usage or knowledge of the Kitajima patent by others in this country as of the U.S. filing date of the Kitajima patent.

Applicants wish to point out specifically that the filing of a patent application in the U.S does ***not*** constitute a knowledge or usage for the purpose of §102(a), since it has been well established in the U.S. patent law that knowledge or usage under §102(a), must be ***publicly available***, and that private or secret knowledge will not constitute prior art.[1] Thus, Applicants believe that the present invention was ***not*** known or used by other in the U.S. at the time of filing in the U.S.

Since there is no evidence of usage of knowledge of the Kitajima patent before the invention date of the present application, Applicants believe that the Kitajima patent is ***not*** prior art under §102(a). The invention date of the present application is at the latest ***February 25, 2003***, which is the later of the Japanese filing dates of the two Japanese priority applications to which the present application claims right of priority under 35 U.S.C. §119. (Please note that the receipt of all certified copies of the priority documents has been acknowledged by the Office Action.) Clearly, the invention date of the present application is ***before*** the publication date of the Kitajima patent, which is ***August 7, 2003***. Thus, Applicants believe that the Kitajima patent does ***not*** qualify as prior art under 35 U.S.C. §102(a).

Rather, Applicants believe that the Kitajima patent is prior art under §102(e), as MPEP 2132.01 specifically sets forth that

---

[1] See *Lockheed Aircraft Corp. v. United States*, 553 F.2d 69, 193 USPQ 449 (Ct. Cl. 1977); *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967); *In re Schlittler*, 234 F.2d 882, 110 USPQ 304 (CCPA 1956).

> Note that when the reference is a U.S. patent published within the year prior to the application filing date, a **35 U.S.C. 102(e)** rejection should be made.

Accordingly, Applicants believe that the Kitajima patent is a prior art under 35 U.S.C. §102(e), but ***not*** under 35 U.S.C. §102(a).

Secondly, Applicants object to the Office Action's assertion that there are inventors that are common in the Kitajima patent and the instant application. The inventor of the Kitajima patent is only Keigo Kitajima, while the inventors of the present application are Yasuhiro Hitomi and Tomohiro Nishikawa. Clearly, there is no common inventorship between the Kitajima patent and the present application.

Thirdly, the inventor of the Kitajima patent and the inventors of the present application were all under the obligation of assignment to assign the invention to Shimano Inc. as its employees at the time of invention. They have in fact assigned their respective inventions to Shimano Inc.

In view of the above comments, Applicants believe that the Kitajima patent is disqualified under §103(c) for the purpose of any rejection under 35 U.S.C. §103.

Furthermore, Applicants believe that none of the prior art of record disclose or suggest the idea of combining ***three*** different materials in the first and second lids and the housing unit. As stated clearly in claims 1 and 12, in the present application, the first lid is made of aluminum alloy, the second lid is made of synthetic resin, and the housing unit is made of a magnesium alloy.

The Wood patent, the Yeh patent, and other prior art of record are silent as to the material from which any part of the reel unit is made.

The Hirayama patent does not disclose or suggest combining three different materials in the first and second lids and the housing unit. The portion of the Hirayama patent (column 5, lines 62-65) cited in the Office Action reads that

> The reel body 1 is made of metal, such as an aluminum alloy ***or*** a magnesium alloy for example, and includes a frame 5, a first side-cover 6 and a second side-cover 7 attached to the two sides of the frame 5.

(emphasis added). In other words, what the Hirayama patent teaches is to form ***all*** of the reel body 1 from aluminum alloy ***or*** magnesium alloy. There is no disclosure or suggestion of making the first and second lids and the housing unit from three different materials.

Accordingly, Applicants believe that the arrangements of claims 1 and 12 are not disclosed or suggested by the Hirayama patent, the Wood patent, the Yeh patent, or any other the prior art of record, whether singularly in any combination.

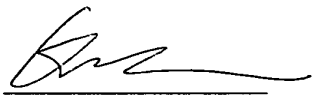
Furthermore, Applicant believes that remaining dependent claims 2-4, 7-11, 13-14, and 17-20 are allowable over the prior art of record in that they depend from independent claims 1 and 12, and therefore are allowable for the reasons stated above.

Accordingly, Applicant respectfully requests withdrawal of the rejections.

* * *

In view of the foregoing amendment and comments, Applicants respectfully assert that claims 1-4, 7-14, and 17-20 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested.

Respectfully submitted,



Kiyoe K. Kabashima
Reg. No. 54,874

SHINJYU GLOBAL IP COUNSELORS, LLP
1233 Twentieth Street, NW, Suite 700
Washington, DC 20036
(202)-293-0444
Dated: Oct 6, 2005

G:\09-SEP05-MT\SN-US030011 Amendment.doc